

AMENDMENT UNDER 37 C.F.R. § 1.111

Appln No.: 10/593,468

REMARKS

I. Status

Claims 1 and 5-8 are all the claims pending in the application.

Claim 1 has been amended to recite that the claimed surface substrate film is a single film. Support is found, for example, in the Examples disclosed on pages 17-20 of the specification as filed.

No new matter has been introduced. Entry and consideration of the amendments are respectfully requested.

II. Response to Rejection of Claims 1 and 5-8 under 35 U.S.C. § 103

Claims 1 and 5-8 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sugino et al. (JP 2003-313330, Examiner's translation) in view of Kotani et al. (US 5380572) and in further view of Watanabe et al. (US 5795650).

Applicants respectfully traverse.

The rejections should be withdrawn at least for the following reasons.

(1) Sugino does not teach or suggest the features of amended claim 1. Namely, Sugino not teach or suggest a surface substrate film as recited that is a single film.

Sugino discloses a polyolefin-based resin laminated film, wherein a coating film layer containing an acrylic modified urethane resin is *laminated* onto at least one surface of a polyolefin-based resin substrate film, and the ratio of the tensile modulus of the coating film layer (JIS K7127) to the tensile modulus of the substrate film (JIS K7127), *i.e.*, the tensile modulus of the coating film layer / the tensile modulus of the substrate film, is 1 to 4.5.

However, the substrate film as recited in amended claim 1 is one layer. More particularly, the substrate film of the present invention does not contain a coating film layer

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containing an acrylic modified urethane resin.

Accordingly, the substrate film of the present invention is different from the substrate film of Sugino.

(2) Regarding Watanabe, Watanabe does not teach or suggest a polyethylene resin film as recited for the following reasons.

Watanabe discloses a pressure-sensitive adhesive sheet to be used for a liquid crystal cell of a liquid crystal display, comprising; a base material layer formed into a light polarizing sheet or a phase difference sheet used in the liquid crystal display; and a pressure-sensitive adhesive layer including an acrylic based pressure-sensitive adhesive composition and a plasticizer, wherein the weight-average molecular weight of the main polymer of the pressure-sensitive adhesive composition of said pressure-sensitive adhesive layer is 600,000 to 2,000,000 whereby stress which would be produced by contraction of said base material layer is relieved by the pressure-sensitive adhesive layer to prevent color unevenness or white marking from appearing on the liquid crystal display.

That is, the plasticizer of Watanabe is an essential component in the pressure-sensitive adhesive layer in Watanabe. In this regard, Watanabe discloses that "an object of this invention is to provide a pressure-sensitive adhesive sheet which can relieve the stress which is produced by the contraction or shrinkage of the base material layer and with which stress concentration can be minimized, while firm bonding with respect to the base material layer being maintained. In particular, an object of the present invention is to provide a pressure-sensitive adhesive sheet with which occurrence of the white marking and color unevenness of liquid crystal cells can be suppressed."

Thus, in order to achieve the object of Watanabe's invention, a plasticizer in the

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pressure-sensitive adhesive layer is an essential component. On the other hand, the claimed polyethylene resin film is composed of a mixture of a low density polyethylene resin and a high density polyethylene resin as recited. Further, removing the plasticizer from the composition of Watanabe would have been difficult for one of ordinary skill in the art and would have rendered Watanabe unsuitable for its intended purpose.

Further still, one of ordinary skill in the art would not have combined the disclosures of Sugino and Watanabe, which each have different objects.

(3) One of ordinary skill in the art would not have modified the disclosure Sugino with Kotani for the following reason. Kotani discloses that "The present invention accordingly has an object to provide a pressure sensitive adhesive label sheet which has excellent appearance when a label mark is printed on a transparent film or on a white opaque film, follows the elongation of the substrate well even after being printed and can be handled smoothly in the process by an automatic labeling machine." That is, the pressure sensitive adhesive label sheet of Kotani is used to apply on a substrate having an elongation property.

However, the motor vehicle brake disc antirust film of the present invention is applied on the wheel of a motor vehicle, and the wheel of a motor vehicle does not have an elongation property. Also, Sugino and Watanabe does not disclose that the pressure sensitive adhesive sheet is applied on an article having an elongation property.

A further aspect of the pressure sensitive adhesive label sheet of Kotani is that it is handled smoothly in the process by an automatic labeling machine. However, the motor vehicle brake disc antirust film of the present invention is not handled by a process using an automatic labeling machine. And, importantly, Sugino and Watanabe do not disclose a pressure sensitive adhesive sheet that is handled in a process using an automatic labeling machine.

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That is, the objects of Sugino's invention and Watanabe's invention are different from the object of Kotani's invention. Accordingly, one of ordinary skill in the art would not have combined Kotani, Sugino, and Watanabe as suggested in the Office Action in view of the significantly different objects of each.

(4) Applicants respectfully traverse the Examiner's apparent characterization of Kotani based on a theory of inherency. As best understood by Applicants, the Examiner's line of reasoning is that the LLDPE and the HDPE taught by Kotani at column 3, lines 20-24 *inherently* have density values as recited in claim 1.

The calculations set forth on page 4 of the Office Action appear to be cited as evidence of the values of the polyethylene of Kotani. Namely, the Examiner calculates a hypothetical 50/50 blend of a hypothetical PE falling within the range of the claimed high density polyethylene resin and a hypothetical PE falling within the range of the claimed low density polyethylene resin. The Examiner's calculation yields 0.941 g/cm^3 , which falls within the range disclosed by Kotani. The Examiner concludes that the properties of the PE blend of Kotani are identical to the properties of the claimed polyethylene resin film.

However, Kotani does not teach or suggest either of the polyethylene resins as recited in claim 1. Following the Examiner's rationale, it is equally as possible that Kotani blends a HDPE having a density higher than that presently claimed with a LDPE having a density lower than that presently claimed while yielding the same calculated average density. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Accordingly, Applicants submit that Kotani does not disclose either expressly or inherently the components recited in claim 1.

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Further, claim 1 does not recite an average density--or a range of average densities--of the claimed mixture. Rather, claim 1 recites a particular density range for the claimed low density polyethylene resin and a separate particular density for the claimed high density polyethylene resin. Accordingly, Applicants submit that, even in view of the Examiner's calculations, not all the claim limitations have been considered and a *prima facie* case of obviousness has not been set forth.

Reconsideration and withdrawal of the rejections are respectfully requested.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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